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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/851,911

05/09/2001

John G. Posa

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09/27/2002

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EXAMINER

KAVANAUGH, JOHN T

ART UNIT

PAPER NUMBER

3728

10

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/851,911

Applicant(s)

POSA, JOHN G.

Examiner

Ted Kavanaugh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Election/Restrictions

1. Claims 7-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.
2. Applicant's election without traverse of group I (claims 1-5) in Paper No. 6 is acknowledged.

Opening Comments

3. It should be noted that the amendment claim 1 doesn't include all of the limitations of now cancelled claim 2. It should be noted that claim 2 (now cancelled) included the range of 3/16 to 3/8 inch and 1/8 to 3/16 inch. The amended claim 1 recited broader language in this regard and therefore a 35 USC 102/103 alternative rejection has been applied.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1,3,4,13 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 9111924 (Ellis).

Ellis teaches footwear substantially as claimed including a sole portion having a bottom surface with a densely packed matrix of projections (projections are formed by slits 151; see figures 11A,11B,8A,9) and a non-partitioned border surrounding the matrix (see figures 10A,10B and 10C). It would appear the projections have the dimensions as claimed ("nominal length of 3/16 or greater" and "nominal width of 1/8 inch or greater") but assuming they don't, the selection of a suitable size of the projections, would appear to constitute no more than optimization of size by routine experimentation inasmuch as a number of thickness would appear to be suitable depending on the individual wearer and the type of footwear being constructed. That is, the size of the projections (the thickness of the sole) is recognized in the art to be a variable that is result effective. Generally, it is considered to have been obvious to develop workable or even optimum ranges for such variables. For example, see *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955) and *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Since the applicant has not demonstrated or even alleged that the specifically claimed size produces unexpected results, it is our conclusion that it would have been obvious for an artisan with ordinary skill to determine a workable or even optimum size for the projections and thereby arrive at the size (i.e. length and width) as claimed by the applicant.

Regarding claims 3 and 13-14, figures 11A and 11B of Ellis show the projections having square and hexagonal shapes. Ellis also teaches the bottom surface can have a plurality of different shapes including circles, see page 19, line 31 to page 20, line 34

The projections are inherently capable of being selectively removed and therefore leave personalized imprints on wet sand or other surfaces. Moreover, Ellis teaches the sole portions can be removed, "The darkened squares indicate that shoe sole portions can be removed to provide tread or cleat-like shoe soles", pg. 20, lines 3-5.

7. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis '924.

Ellis teaches footwear substantially as claimed (see the rejection above) except for the projections being triangular and rectangular. Figures 11A and 11B of Ellis show the projections having square and hexagonal shapes. Ellis also teaches the bottom surface can have a plurality of different shapes including circles, see page 19, line 31 to page 20, line 34. It would have been an obvious matter of design choice to make the projections of whatever form or shape was desired or expedient such as being triangular and rectangular. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis '924.

Ellis teaches footwear having a sole portion having a bottom surface with a densely packed matrix of projections extending there from (see figures 11A and 11B) wherein each projection is inherently capable of being removed (moreover, Ellis teaches that the sole portions can be removed; see pg. 20, lines 3-5) substantially as claimed except for the footwear comprising a sandal or thong. Ellis teaches "This invention relates generally to the structure of shoes. More, specifically...athletic shoes", pg. 1, lines 4-6. The term shoes in the art include sandals. Therefore, it would have been obvious to provide the sole portion as taught above as part of a sandal or thong, to provide traction to the footwear.

The projections are inherently capable of being selectively removed and therefore leave personalized imprints on wet sand or other surfaces. Moreover, Ellis teaches the sole portions can be removed, "The darkened squares indicate that shoe sole portions can be removed to provide tread or cleat-like shoe soles", pg. 20, lines 3-5.

9. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis '924 in view of US 5084988 (Berger).

Ellis teaches footwear having a sole portion having a bottom surface with a densely packed matrix of projections extending there from (see figures 11A and 11B) wherein each projection is inherently capable of being removed (moreover, Ellis teaches that the sole portions can be removed; see pg. 20, lines 3-5) substantially as claimed except for the sole portion being at least partially transparent to enable a user to look through the sole portion. Berger teaches a sole portion that is partially transparent

(8,9,3,4 are all transparent) to permit viewing of the toe tips. It would have been obvious to provide the sole as taught by Ellis to being transparent, as taught by Berger, to permit to permit viewing the toes within the shoe to determine whether the shoe is too small.

Regarding the functional claim language, the shoe sole as taught above is transparent and the projections are inherently capable of being removed and therefore the user is inherently capable of looking the shoe sole and remove the projections. Moreover, Ellis teaches the sole portions can be removed, "The darkened squares indicate that shoe sole portions can be removed to provide tread or cleat-like shoe soles", pg. 20, lines 3-5.

Response to Arguments

10. Applicant's arguments filed August 26, 2002 have been fully considered but they are not persuasive.

The Taber rejection has been withdrawn in view of the amended claims.

Regarding Ellis, applicant argues that "there is no foundation for the argument that incorporation of any type of sole into a sandal or thong provides any traction, or additional traction"

The examiner doesn't fully understand applicant's argument but it would appear applicant is arguing that the shoe sole of Ellis is with regard to shoes that desire to have traction and sandals and thongs don't desire traction. The examiner disagrees with this point. Sandals and thongs are known in the art to desire traction to. Specifically, sports sandal have a plurality of traction elements on the bottom of the shoe sole.

Applicant argues that "Applicant had alleged and demonstrated unexpected results, namely, the selective removal of the projections to produce a personalized footprint, an aspect with the cited references are silent".

In response, Ellis does teach selected portions of the shoe sole bottom can be removed but nonetheless the projections are inherently capable of being removed. Ellis teaches the shoe sole having structure substantially as claimed. All of the functional claim language and statements of intended use do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

Regarding the Ellis in view of Taber rejection, applicant argues that the prior art doesn't suggest a reason to combine these references.

In response, Berger teaches a sole portion that is partially transparent (8,9,3,4 are all transparent) to permit viewing of the toe tips, see col. 1, lines 38-44.

Applicant also argues that the reason suggested by the examiner is a different that reason than what applicant's is used for.

It has been held that "[a]s long as some motivation or suggestion to combine references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. In re Beattie, 24 USPQ2d 1040, 1042 (1992); also see In re Kronig, 539 F.2d 1300, 1304, 190 USPQ 425, 427-28 (CCPA 1976), and also see In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111. Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

12. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9302 and After Finals to (703) 872-9303 (FORMAL FAXES ONLY). If the previous Fax numbers are not working use any of the following numbers (703) 305-3579 or (703) 305-3580 or (703) 305-3590. Applicants who authorize charges to a PTO deposit account may also use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc.; requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

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Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
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If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/


Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
September 26, 2002